

DOCKET NO: UPN0015-103/N2492
PATENT APPLICATION

Serial No.: 09/977,716
Filed: 10/15/2001

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REMARKS

Status of the Claims

Claims 1 and 15-29 are in the application.

Claims 1 and 15-29 have been rejected.

By way of this amendment, claims 1, 15, 21-24 and 26 have been amended, claim 17 has been canceled and new claims 30-34 have been added.

Upon entry of this amendment, claims 1, 15, 16 and 18-34 will be pending.

Summary of the Amendment

Claims 1 and 23 have been amended to more clearly set forth the subject matter of the invention. As amended, claims 1 and 15 more clearly defines the product of RNA amplification such that it is clear that the amplified product which is produced, stained and detected is a product of an RNA amplification procedure which is performed using the oligonucleotide as a template. Claims 1 and 15 have also been amended to refer to an RNA promoter present on the oligonucleotide and the to more clearly set forth that the RNA amplification procedure that produces an amplified RNA product. Claim 22 has been amended to more clearly refer to the RNA amplification product. Support for these amendments are found throughout the specification such as on page 11 of the specification.

Claim 1 again recites the list of molecule types which are included as epitope detectors. Some members of the list were inadvertently omitted in the previous listing of the claims. No amendment was intended to delete this subject matter so the language is not designated as newly added.

Claim 1 has additionally been amended to incorporate the subject matter of claim 17, which has been canceled as redundant.

Claim 23 and 26 have been amended to include in the claims members of the list of molecules used as epitope detectors which were inadvertently omitted when the claim was submitted.

Claim 26 has also been amended to correct an obvious spelling error.

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Claims 15 and 24 have been amended to refer to embodiments in which molecules are immobilized to the selected surface using epitope anchors. Support for the amendment is found throughout the specification such as on pages 3 and 5 of the specification.

Claim 21 has been amended to revise the dependency in view of the cancellation of claim 17 and the incorporation of the subject matter of claim 17 into claim 1.

New claims 30-33 refer to specific embodiments of the invention.

No new matter has been added.

Rejection under 35 U.S.C §112, second paragraph

Claims 1 and 15-29 were rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

It has been asserted that claims 1 and 15-29 are vague and indefinite because it is unclear whether or not the "amplified oligonucleotide," "oligonucleotide" and "stained oligonucleotide" refers to RNA produced by the RNA amplification procedure.

Claims 1 and 23 have been amended to more clearly indicate that the RNA amplification procedure produces an "amplified RNA product," and that the "amplified RNA product" is contacted with fluorescent dye to produce a "stained amplified RNA product." As amended the claim is clear and definite.

The omission from claim 1 of members of the list of molecule types which are included as epitope detectors was pointed out. As noted above, the omission was inadvertent. Claim 1 as set forth contains a original listing and claims 23 and 26 have been amended to include the inadvertently omitted members as well.

The claims are clear and definite. Applicant respectfully requests that the rejection of claims 1 and 15-29 under 35 U.S.C §112, second paragraph, as applied to claims 1, 15, 16 and 18-29 be withdrawn.

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Rejection under 35 U.S.C §103(a)

Claim 1 was rejected under 35 U.S.C §103(a) as being unpatenable over Eberwine et al (U.S. Patent No. 5,922,553) in view of Chu et al. (U.S. Patent No. 5,631,129).

Eberwine discloses detecting protein using immuno aRNA. Eberwine discloses using an epitope specific monoclonal antibody covalently coupled to an oligonucleotide which serves as an aRNA template an Eberwine does not disclose using fluorescent dye to stain amplified RNA.

Chu et al. discloses staining RNA using the fluorescent dye ethidium bromide.

Claim 1 has been amended to incorporate the limitations of claim 17 which indicate that the oligonucleotide used as the aRNA template is attached to the epitope detector using biotin-streptavidin.

Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C §103(a) as being unpatenable over Eberwine et al (U.S. Patent No. 5,922,553) in view of Chu et al. (U.S. Patent No. 5,631,129) be withdrawn.

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Conclusion

Claims 1, 15, 16 and 18-34 are in condition for allowance.

As indicated on the transmittal accompanying this response, the Commissioner is hereby authorized to charge any debit or credit any overpayment to Deposit Account No. 50-1275.

The examination of these claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at 215.665.5592 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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